



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.														
10/537,688	06/06/2005	Min Kyun Na	428.1054	8393														
7590 Michael N. Mercanti Lucas & Mercanti 475 Park Avenue south New York, NY 10016		11/28/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">MELLER, MICHAEL V</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1655</td><td></td></tr><tr><td colspan="2"><table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>11/28/2007</td><td>PAPER</td></tr></table></td></tr></table>		EXAMINER		MELLER, MICHAEL V		ART UNIT	PAPER NUMBER	1655		<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>11/28/2007</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	11/28/2007	PAPER
EXAMINER																		
MELLER, MICHAEL V																		
ART UNIT	PAPER NUMBER																	
1655																		
<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>11/28/2007</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	11/28/2007	PAPER													
MAIL DATE	DELIVERY MODE																	
11/28/2007	PAPER																	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,688	Applicant(s) NA ET AL.	
	Examiner Michael V. Meller	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 1-11 in the reply filed on 3/26/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Newly submitted claims 14-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the composition as claimed can be used in a materially distinct process such as treating cancer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Claims 12 and 13 are already on the record as being drawn to non-elected inventions. Accordingly, claims 12-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The restriction requirement is still deemed to be proper thus it is made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. in view of Ma et al., CN 1294926, JP 61200922, DE 20009867 and JP 10245075.

Kim teaches that *Cercis chinensis* (Chinese redbud) is extracted with methanol and both myricitrin and gallic acid are yielded in that extraction, see abstract.

Kim does not teach that the extraction is done with at least 60 % ethanol, that the extract is in a composition also containing surfactants and are in a pack.

Ma teaches that 95 % ethanol is routinely done with *Cercis chinensis*, see abstract.

CN teaches that Chinese redbud is known to be used in capsule form, see abstract.

JP '922 teaches that tablets and capsules are commonly used with plant extracts, see abstract.

DE teaches that tablets commonly contain surfactants and plant extracts, see abstract.

JP '075 teaches that tablets are commonly in packs, see abstract.

It would have been obvious at the time the invention was made to extract the *Cercis chinensis* of Kim with 95 % ethanol since Ma makes it clear that 95 % ethanol optimized the pigment extraction. It also would have been obvious to use *Cercis chinensis* in capsule form since CN makes it clear that *Cercis chinensis* is known to be used in capsule form to treat angina pectoris and JP '922 makes it clear that tablets and capsules are both commonly used with plant extracts. DE makes it clear that tablets commonly contain surfactants and plant extracts thus making it obvious to add surfactants to tablets since they are routinely used in tablet making. To put the tablets into packs is also obvious since as shown by JP '075 tablets are commonly put into packs.

Note that even though the Chinese redbud was known to be used to treat angina pectoris, since these are product claims, the references do not have to teach the intended use of the composition.

Applicant argues that Kim does not disclose a cosmetic composition, but as noted above the claims are product claims and not method of use claims. Applicant also argues that CN '926 indicates that there are 12 different extracts, and thus concludes there cannot possibly be enough of the Chinese redbud to constitute a main ingredient, but this is not well taken since the claims are not so limited to require any

amounts of the Chinese redbud. Applicant also argues that since CN '926 uses 12 ingredients that it is not obvious to use only one component, but the claims are not so limited. Applicant argues that Ma yields anthocyanin which it does not.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1294926 in view of Li et al., JP 61200922 and Kosuge et al.

CN teaches that Chinese redbud is known to be administered for pharmaceutical use in capsule form, see abstract.

CN does not teach that the Chinese redbud is extracted with ethanol, in tablet form or that it contains diluents with it.

Li teaches that Chinese redbud is well known to be extracted with ethanol, see abstract.

JP teaches that plant extracts are both used in tablet and capsule form, see abstract.

Kosuge teaches that tablets are known to contain diluents, see col. 3, lines 55-end.

It would have been obvious at the time the invention was made to use ethanol to extract the Chinese redbud since Li makes it clear that ethanol is known to be used as a common extractant such as for extracting Chinese redbud to be used in food which is edible as a capsule is. It is also obvious to use capsule or tablet since JP makes it clear

that plant extracts are commonly in either tablet or capsule form. It also would have been obvious to use a diluent with the tablet since Kosuge makes it clear that tablets commonly contain diluents.

All of the arguments that applicants made about the references of record have been addressed above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-

Art Unit: 1655

0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'M. V. Meller', followed by a long horizontal line extending to the right.

Michael V. Meller
Primary Examiner
Art Unit 1655